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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,458	06/26/2001	Yasuyuki Miyazawa	1576.89	4193

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EXAMINER

HABTE, KAHSAY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,458

Applicant(s)

MIYAZAWA ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 7-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-34 are pending.

Response to Amendment

2. Applicant's amendment filed 8/8/03 in response to the previous Office Action (Paper No. 17) is acknowledged. Rejections of claims 1-6 under 35 U.S.C. § 112, second paragraph (Paper No. 14, paragraph 5a) has been obviated. The prior art rejection (Paper No. 17, item 3) and the first paragraph rejection in item 4 (Paper No. 17) have been maintained.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

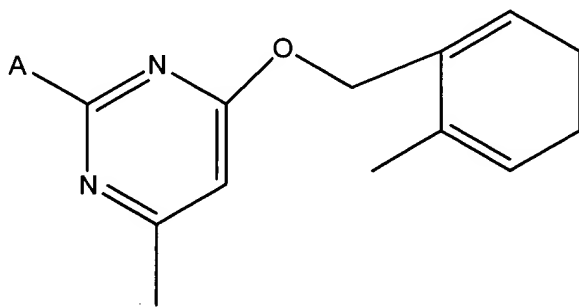
Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sunley et al. (DE 27 34 827A1). The cited German patent teaches the synthesis of alkyl substituted pyrimidines. Specifically, on pages 11-16 (Table 1) compounds 19, 48 and 54 are the same as applicants. Said compounds are the same as applicants when applicant's formula (II) has the following substituents:

E = alkyl and t = 2.

Response to arguments

Applicants' arguments filed 08/08/2003 have been fully considered but they are not persuasive.

Applicants argue "historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim." The examiner disagrees with applicants. Sunley discloses (a) 2,4-dimethyl-6-[(2-methylphenyl)methoxy]-Pyrimidine; (b) 4-methyl-2-(1-methylethyl)-6-[(2-methylphenyl)methoxy]-Pyrimidine; and (c) 2-butyl-4-methyl-6-[(2-methylphenyl)methoxy]-Pyrimidine that are the same as applicants.



A = methyl for (a)

A = isopropyl for (b)

A = n-Butyl for (c).

Applicants also argue "Sunley only teaches the synthesis of methyl substituted benzyloxy pyrimidines. To the contrary, Claim 5 claims a compound having a formula (I) wherein R₁ is pyrimidinylloxymethylphenyl and claim 6 is a compound having a formula (II)." Sunley does not teach only methyl, but it teaches isopropyl and butyl and

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also teaches R1 = pyrimidinylloxymethylphenyl. The examiner has attached an STN search report that contains said three species from Sunley.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1 and 5, the phrases "alkyl optionally substituted by alkoxy", "alkoxy optionally substituted by halogen or aryl", "aryloxy optionally substituted by alkoxy", etc. lack descriptive support in the specification. Applicants have amended claims 1 and 5 to overcome the rejection under 35 U.S.C. 112, second paragraph (Paper No. 14, item d). For example, in claim 1 the phrase "optionally substituted alkyl" is amended to read as "alkyl optionally substituted by alkoxy", but there is no descriptive support for the new phrase "alkyl optionally substituted by alkoxy."

Response to arguments

Applicants' arguments filed 08/08/2003 have been fully considered but they are not persuasive.

Applicants argue the phrases "alkyl optionally substituted by alkoxy", "alkoxy optionally substituted by halogen or aryl", "aryloxy optionally substituted by alkoxy" are supported in the specification. Applicants argue the phrase "alkyl optionally substituted by alkoxy" is supported by "methoxymethyl" in the specification on page 27, line 6. Likewise, "alkoxy optionally substituted by halogen or aryl" is supported by trifluoromethoxy and benzyloxy (phenylmethoxy) in the specification on page 27, line 9. The examiner disagrees with applicants. The scope of "methoxymethyl" in the specification does not amount to the scope "aryloxy optionally substituted by alkoxy" in the claim, because methyl is embraced by alkyl and not the vice versa. The same is true for "benzyloxy." Applicants are entitled only to "methoxymethyl", "benzyloxy" for which they have support in the specification, but not to the broader term that lack descriptive support.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1624

KH
September 1, 2003